



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,666	12/27/1999	KEITH C. THOMAS	98-1176	9062

24333 7590 04/24/2002

GATEWAY, INC.
ATTN: MARK S. WALKER
610 GATEWAY DRIVE
MAIL DROP Y-04
N. SIOUX CITY, SD 57049

EXAMINER

KEMPER, MELANIE A

ART UNIT PAPER NUMBER

3622

DATE MAILED: 04/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

RA

Office Action Summary

Application No.

09/472,666

Applicant(s)

THOMAS, KEITH C.

Examiner

M Kemper

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 27 December 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Claims 1,3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims lack the steps of the method for placing products in a moving media where inserting the product item restates the placing of products in the moving media. The steps of the method to achieve the insertion of the product have not been defined. Without clearly defining the invention these claims read on any product placement in any type of medium.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-5 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Freeman, "Eyemark Expands Virtually" Mediaweek, vol. 9, n. 7, pp.9(1) 2/15/99.

The article teaches the virtual product placement claimed.

4. Claims 1,3-5 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Ross, "Warner Bros. To Test 'Virtual' Ad Concept: TV Group Would Be First Big Syndicator to Use Technology" Advertising Age, 5/17/99.

The article teaches the virtual product placement claimed.

5. Claims 1-5 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Battaglio, "'Virtual' Product Placing Gets Real in UPN" Hollywood Reporter, vol. 357, no. 4, p. 1, 3/25/99.

The article teaches the virtual product placement claimed.

6. Claims 1,3-5 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by "Special FX Marketing" US Distribution Journal (5/1999).

The article teaches the virtual product placement claimed.

7. Claims 1,3-6 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by "Virtual Ads, Real Problems" Advertising Age, 5/24/99.

The article teaches the virtual product placement claimed including the selling of the placement of products which inherently includes the steps of dividing the time over which the content is released into a plurality of time slots since this step is necessary for determining "later airing".

8. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Sitnik.

Sitnik teaches a method for placing products in a moving media as claimed (see at least col. 2, lines 15-30, 40-55, col. 4, lines 5-35, col. 8, lines 35-55, col. 9, lines 10-67)

Art Unit: 2165

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Virtual Ads, Real Problems in view of Sitnik, patent number 6,160,570.

The article teaches a method of selling the placement of products, but does not teach selling based on geographic versions or the channel version (medium).

Sitnik teaches product placement based on geographic versions and channel versions (see at least col. 4, lines 5-35, col. 8, lines 35-60, col. 9, lines 10 – col. 10, line 5). It would have been obvious to one having ordinary skill in the art at the time of the invention to have sold product placement in view of geographic regions and the channel type since these parameters would have been adopted for the intended use of reaching the target audience.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M Kemper whose telephone number is 703-305-9589. The examiner can normally be reached on M-F (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7240 for After Final communications.

Art Unit: 2165

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



M Kemper
Primary Examiner
Art Unit 2165

MK
April 22, 2002